

VTI-114.4 B

RESPONSE TO NON-FINAL OFFICE ACTION

MAILED September 20, 2004

Page 8 of 13

III. REMARKS

Reconsideration of the application is requested. Claims 2-6 are pending. Claim 2 have been amended and claim 1 canceled, without prejudice. Claims 3-6 have been newly added. No new matter has been introduced with this amendment which is fully supported by the Specification, in particular on pages 8 and 9.

Rejections of Claims

Rejections under 35 USC 112

- **Examiner's Position:**

Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble of claim 2 recites "a compound" and the body of the claims includes a description of a compound and a physical structure. For the purposes of evaluating prior art, the contacting with a structure is considered an intended use.

The groups recited for X and Y do not include clearly some of the groups exemplified in figure 1. The applicant may wish to correct this with active recitations.

- **Applicant's Response:**

Applicant respectfully traverses the rejection under the statute because amended Claim 2 as well as newly added independent claims 3-6 are directed to copy-protected optical medium containing a thiazine compound capable of transient optical phase push-pull changes

VTI-114.4 B

RESPONSE TO NON-FINAL OFFICE ACTION

MAILED September 20, 2004

Page 9 of 13

demonstrating an optical change when exposed to the defined wavelengths of a typical CD optical reader at about 770 nm to about 830 nm. Furthermore, the compounds X and/or Y are characterized by the an optional cyano substituent group, but absence of halogen. Applicant, therefore, respectfully requests withdrawal of these rejections.

Rejections under 35 USC 102

Examiner's Position:

Pursuant to the action of the Examiner, Claims 1-2 are rejected under 35 USC 102(b) as being fully anticipated by Chandra et al. "Studies on some new phenothiazines", Can. J. Chem., Vol. 45, pp. 761-767 (1967). 3-Chloro-7-ethoxy, 3-bromo-7-methoxy and 3-Bromo-7-ethoxy phenothiazines are allegedly described in Table IV on page 765 and Table II on page 763.

Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being fully anticipated by Selinfreund et al. 2004/0004922. See figure 6.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Saraf, et al. "Recent advances in the synthesis of phenothiazines", Heterocycles, Vol. 26(1) pp.239-273; in particular, the 3-Chloro-7-ethoxy, 3-Bromo-7-methoxy and 3-Bromo-7-ethoxy phenothiazines described in Table I on page 243; compound 39, where R=R₂= Hydrogen and R₁ is NO₂ or Cl on page 251, compound 47, where R is NO₂ or CF₃ on page 252, the 1,3-dinitro-7-ethoxy, 1-nitro-3-chloro-7-ethoxy, 3-nitro-7-ethoxy, 1,7-dinitro-3-methoxy, 1,7-dinitro-3-ethoxy, and other phenothiazines described in table on page 257 and 258. See also compounds 89 and 90

110163698v.1

VTI-114.4 B

RESPONSE TO NON-FINAL OFFICE ACTION

MAILED September 20, 2004

Page 10 of 13

on page 263.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Aramaki et al. JP 08-122836, formula 1 and phenothiazine compounds listed on pages 4 and 6.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Kubo et al. JP 01-228976, formula 1 and phenothiazine compounds listed on pages 4 and 5.

Applicant's response:

Applicant respectfully traverses this allegation because the instant computer-readable disk are distinct and different from the cited disclosure. On the contrary, the instant claims are not disclosed or suggested by the cited prior art. However, in order to expedite the allowance of the application, Applicant respectfully submits the present amendment of the claims. Claim 1 is canceled, its rejection is therefore moot. Claim 3 is directed to a selection of thiazine compounds of structures believed free of the cited art. In particular, the cited reference to Selinfreund 20040004922 Fig. 6, is not proper prior art as it is an invention by the same inventive entity as well as claiming the same Provisional Application No. 60/413,934, filed September 26, 2002, as the instant, above-identified patent application.

Newly added claims 4-6 are directed to the instant working examples for use in the optical disk invention is not described or suggested by the cited art. Moreover, the advantageously changeable read optical disk due to the claimed compounds is deemed surprising over the cited references.

In view of this submission, the rejection of the claimed subject matter over the

110163698v.1

VTI-114.4 B

RESPONSE TO NON-FINAL OFFICE ACTION

MAILED September 20, 2004

Page 11 of 13

cited art is deemed moot. Therefore, withdrawal of the non-final rejection is solicited.

VTI-114.4 B

RESPONSE TO NON-FINAL OFFICE ACTION
MAILED September 20, 2004
Page 12 of 13

Other Prior Art:

The Examiner has made the following prior art of record but not relied upon.

Daneke et al, "Addition von Nucleophilien an *in situ* erzeugtes Phenoazathionium - Kation", Liebigs Ann. Chem., Vol 740, pp. 52~62 (1970) and Cauquil, et al. Bull. Soc. Glum. France (1955), pp. 10614075 allegedly teach various phenothiazines and their synthesis.

Morrison & Boyd, "Organic Chemistry", pp. 360(1973) allegedly teaches electron releasing and electron donating moieties.

Rollhaus et al. '772 allegedly teach the use of methylene blue (a phenothiazine) in the copy prevention of optical recording media.

Applicant has reviewed these references and respectfully asserts that the references do not disclose or suggest the presently claimed invention. No further comment is deemed necessary at this time.

VTI-114.4 B

RESPONSE TO NON-FINAL OFFICE ACTION

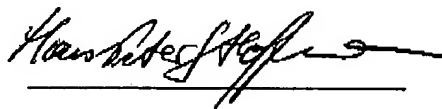
MAILED September 20, 2004

Page 13 of 13

CONCLUSION

The application is now believed to be in condition for allowance and an early notification thereof is respectfully requested.

Respectfully submitted,



Dated: January 20, 2005.

Hans-Peter G. Hoffmann, PhD
Reg. No. 37,352
PILLSBURY WINTHROP LLP
FINANCIAL CENTRE
695 EAST MAIN STREET, 3-A
STAMFORD, CT 06901
Telephone: 203-965-8271
Facsimile: 914 407-1603
e-mail: hhoffmann@pillsburywinthrop.com

Enclosure

110163698v.1